



IFW

**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Izuo AOKI et al.

Group Art Unit: 1621

Application No.: 09/486,981

Examiner: E. PRICE

Filed: February 28, 2000

Docket No.: 145084

For: MOLECULAR COMPOUNDS CONTAINING PHENOL DERIVATIVES AS  
CONSTITUENT**RESPONSE TO RESTRICTION REQUIREMENT**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the December 2, 2010 Restriction Requirement, Applicants provisionally elect Group I, claims 35-41, with traverse.

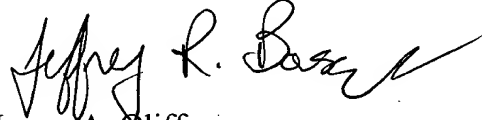
National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. See MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. See MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

The Office Action does not establish that there is a lack of *a priori* or *a posteriori* unity of invention. Thus, the restriction requirement is *per se* improper, and should be withdrawn.

Respectfully submitted,



James A. Oliff

Registration No. 27,075

Jeffrey R. Bousquet

Registration No. 57,771

JAO:JRB

Date: December 20, 2010

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 320850**  
**Alexandria, Virginia 22320-4850**  
**Telephone: (703) 836-6400**

**DEPOSIT ACCOUNT USE  
AUTHORIZATION**

Please grant any extension  
necessary for entry of this filing;  
Charge any fee due to our  
Deposit Account No. 15-0461